

Remarks

Favorable reconsideration of this application is requested in view of the above amendments and the following remarks. Claims 1, 3, 5-6, 10-11, 13-14, 16, 21-22 and 24-26 are amended. Claims 1-26 remain pending in the case. No new matter has been added. Reconsideration of the claims is respectfully requested.

A. Objection to the Specification

In paragraph 2 on page 2 of the Office Action, the Specification was objected to because it contains an embedded hyperlink and/or other form of browser executable code.

Applicant respectfully traverses the objection to the Specification, but in order to advance prosecution of this application, Applicant has amended the Specification and is submitting amended paragraphs on a separate sheet attached herewith. The amended paragraphs clarify the Specification and claims without adding new matter.

Therefore, in view of the above remarks, Applicant respectfully requests that Examiner withdraw the objection.

B. Rejection Under Rule 1.75(c)

In paragraph 3 on page 2 of the Office Action, claim 11 was objected to under 37 CFR 1.75(c), as being improper form because it depends on both dependent claims 5 and 8.

Applicant respectfully traverses this objection, but in the interest of advancing prosecution of this application has amended claim 11 to depend solely from independent claim 1.

Therefore, in view of the above remarks, Applicant respectfully requests that the Examiner withdraw the objection.

C. Rejection Under 35 U.S.C. § 112

In paragraph 4 on page 2 of the Office Action, claim 16 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. According to the Office Action, there is insufficient antecedent basis for the limitation "third information."

Applicant respectfully traverses this rejection, but in the interest of advancing prosecution of this application has amended claim 16 and submits that amended claim 16 is now in condition for allowance.

Therefore, in view of the above remarks, Applicant respectfully requests that the Examiner withdraw the rejection.

D. Rejection Under 35 U.S.C. §§ 102(b) and 103(a)

In paragraph 5 on page 3 of the Office Action, claims 1-5, 7-8, 10, 12-17 and 19-26 were rejected under 35 U.S.C. §102(b) as being anticipated by Spurgeon (US 5,890,129). In paragraph 6 on page 9 of the Office Action, claims 6, 9 and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Spurgeon (US 5,890,129) in view of Miller (US 5,608,784). In paragraph 7 on page 10 of the Office Action, claim 18 was rejected under 35 U.S.C. §103(a) as being unpatentable over Spurgeon (US 5,890,129) in view of Ogilvie (US 6,343,738). According to the Office Action, Spurgeon discloses Applicant's invention substantially as claimed.

Applicant traverses these rejections, but in the interest of expediting prosecution has amended the claims to clarify the original, intended scope of the claims.

For example, claim 1 was amended to clarify that certain acts for the method of assembling a database system are performed in a computer system. Claim 22 was similarly amended. Additionally, the term "potential claimant" was amended to "claimant" to clarify that the cited references, alone or in combination, do not disclose, teach or suggest the invention. Applicant submits that there are patentable differences between the cited references and Applicant's invention. Applicant's invention differs from the cited references in at least the following respects.

Claims 1 and 22 of the present invention require at least validating, by a computing system, each of the claims for relief by comparing either of the first or second information against a pre-defined dataset.

Spurgeon fails to disclose or suggest at least validating, by a computing system, each of the claims for relief by comparing either of the first or second information against a pre-defined dataset. Rather, Spurgeon discloses that the staff verifies the member's eligibility and other specific information/codes once the claims processing department receives the claim. If an identical match

exists, the staff member in the claims processing department approves the claim. (col. 10, lines 20-31).

Miller fails to remedy the deficiencies of Spurgeon. Miller fails to disclose or suggest validating, by a computing system, each of the claims for relief by comparing either of the first or second information against a pre-defined dataset. Miller was merely cited for comparing reference strings.

Ogilvie also fails to remedy the deficiencies of Spurgeon and Miller. Ogilvie fails to disclose or suggest validating, by a computing system, each of the claims for relief by comparing either of the first or second information against a pre-defined dataset. Ogilvie was merely cited for disclosing digital signatures to authenticate information.

Therefore, in view of the above remarks, Applicant's independent claims 1 and 22 are patentable over the cited references.

Because claims 2-21, which depend from claim 1, and claims 23-26, which depend from claim 22, include the features recited in the independent claims as well as additional features, Applicant respectfully submits that claims 2-21 and 23-26 are also patentably distinct over the cited references. Nevertheless, Applicant is not conceding the correctness of the Office Action's rejection with respect to such dependent claims and reserve the right to make additional arguments if necessary.

In addition, with respect to dependent claim 12, Applicant's invention requires transmitting a computer application (program) via the computer network, the computer application being configured to receive each of the claims for relief. Spurgeon fails to disclose or suggest transmitting a computer application (program) via the computer network, the computer application being configured to receive each of the claims for relief. Rather, Spurgeon provides local area network (LAN) software as part of an information-exchange system for allowing an information-exchange computer to communicate over the LAN. This LAN software is merely a conduit for data to be transmitted. (col. 6, line 61 - col. 7, line 3). In contrast, Applicant's invention transmits an application (program) as to avoid problems with existing applications for data entry.

Miller fails to remedy the deficiencies of Spurgeon as Miller fails to disclose or suggest transmitting a computer application via a computer network. Ogilvie fails to remedy the deficiencies of Spurgeon and Miller as Ogilvie fails to disclose or suggest transmitting a computer application via a computer network.

Therefore, in view of the above remarks, Applicant's dependent claim 12 is patentable over the cited references.

With respect to dependent claim 13, Applicant's invention requires transmitting a form to a claimant via the computer network, the form being adapted for receiving each of the claims for relief. Spurgeon fails to disclose or suggest transmitting a form to a claimant via the computer network, the form being adapted for receiving each of the claims for relief. Rather, Spurgeon merely discloses that an existing manual or electronic medical record device (i.e., a data entry screen) may be used to enter information. (col. 9, line 43-57; Fig. 9).

More particularly, Spurgeon discloses that pre-existing computer system/data entry applications on the provider's computers and other pre-existing electronic medical record devices are used to enter data. The data is then collected and retransmitted to an information-exchange computer. The pre-existing devices include a PMS system, a proprietary Healthcare Information System (HIS) and HIS software and databases (col. 2, lines 19-29, lines 50-53, and lines 64-67). Further, Spurgeon states, "[t]he present invention is a system of exchanging clinical and business information, within the *existing* environment of disparate hardware and software." (emphasis added) (col. 3, lines 1-5). In contrast, Applicant's invention transmits a form (claim 12) or an application (claim 13) as to avoid problems with existing applications for data entry – allowing Applicant's invention to be configurable for markedly different applications.

Miller fails to remedy the deficiencies of Spurgeon as Miller fails to disclose or suggest transmitting a form to a claimant via a computer network. Ogilvie fails to remedy the deficiencies of Spurgeon and Miller as Ogilvie fails to disclose or suggest transmitting a form to a claimant via a computer network.

Therefore, in view of the above remarks, Applicant's dependent claim 13 is patentable over the cited references.

With respect to dependent claim 19, Applicant's invention requires confirming receipt of the first and second information via the computer network. Spurgeon fails to disclose or suggest confirming receipt of the first and second information via the computer network. Rather, Spurgeon confirms that a benefits package exists. (col. 10, line 22).

Miller fails to remedy the deficiencies of Spurgeon as Miller fails to disclose or suggest confirming receipt of the first and second information via the computer network. Ogilvie fails to

remedy the deficiencies of Spurgeon and Miller as Ogilvie fails to disclose or suggest confirming receipt of the first and second information via the computer network.

Therefore, in view of the above remarks, Applicant's dependent claim 19 is patentable over the cited references.

E. Conclusion

In view of the above, favorable reconsideration in the form of a notice of allowance is requested. Applicant notes that there may be additional arguments that support the patentability of the pending claims, including the claim as originally filed, in addition to those raised above. Applicant reserves the right to raise any such argument in the future. Any questions or concerns regarding this communication can be addressed to the undersigned attorney, John C. Reich, at (612) 336-4608.

Respectfully submitted,

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By



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